

REMARKS/ARGUMENTS

The Office Action of October 6, 2003 has been carefully reviewed and this response addresses the Examiner's concerns stated in the office action.

Claims 1-20 are still pending in the application. Claims 18 and 20 have been amended to correct typographical errors and clarify terminology and not to further define the invention over the applied references.

A Petition for a one-month extension and an extension fee of \$110 for a large entity is attached hereto.

On pages 2-4, paragraphs 1-13 of the Office Action, claims 1-5, 9, 11, 13, 15-16, and 18-20 are rejected under 35 U.S.C. §102(b) as being anticipated by Petrovich et al., United States Pat. No. 6,101,483 (Petrovich).

With regards to independent claim 1, the Examiner states that Petrovich discloses a portable 2-way secure purchasing aid logistics appliance (40) comprising a central processor coupled to said means for inputting information to generate a shopping list, wherein said central processor includes application software to maintain a budget and to perform finance computations ("pay for purchases", col. 5, lines 43). However, The Examiner's citation points to the point-of-sale checkout terminal 56 of Petrovich (col. 5, lines 43). It should be noted that checkout terminal 56 of Petrovich is a standard check-out terminal in a shopping establishment. The point-of-sale checkout terminal 56 of Petrovich is not a part of the portable terminal 40 of Petrovich (see FIG. 4). Further, Petrovich does not disclose that checkout terminal 56 maintains a budget. Nowhere does Petrovich disclose a 2-way portable purchasing aid logistics appliance comprising a central processor that includes application software to maintain a budget and to perform finance computations as set forth in Applicants' invention recited in independent claim 1.

Applicants set forth below further remarks with regard to the patentable distinctions of Applicants' claimed invention of claim 1 over Petrovich. The Examiner states that Petrovich discloses means for securing memory coupled to said central processor to safeguard personal and financial information (col. 4, lines 19-22 and 55-61) (Applicants note that the Examiner must be referring to col. 5, lines 19-22 and 55-61). Applicants respectfully disagree with the Examiner. Applicants respectfully point out, and contrary to the Examiner's position, that Petrovich discloses an optional initialization procedure for entering an appropriate code for security and identification purposes (col. 5, lines 19-22), and a PIN or credit card means for identification and safeguard of portable terminal 40 (col. 5, lines 55-61). Applicants respectfully assert that presenting security codes and identification information to a portable terminal to unlock the software applications and data as disclosed by Petrovich and securing the memory coupled to the central processor as claimed by Applicants, are two fundamentally different actions that are patentably distinct. In particular, Applicants respectfully assert that an unauthorized user may determine a user's PIN or credit card information and access both data and software applications in the invention of Petrovich. In Applicants' invention, memory is secured such that the unauthorized user would not be able to access the user's data without first successfully completing, for example, a three-way verification (Applicants' specification, paragraph 47). Therefore, Applicants respectfully assert that means for securing memory of Applicants' claim 1 is patentably distinguishable from securing the portable terminal itself against access as described by Petrovich.

Since Petrovich does not set forth each and every element of Applicants' claim 1, either expressly or inherently, Applicants' claim 1 (as well as claims 2-5, 9, 11, 13, 15, and 16 that depend therefrom and that further define the invention) is not anticipated by Petrovich and a rejection under 35 U.S.C. §102(b) is inappropriate. Therefore, Applicants respectfully request the withdrawal of rejections under 35 U.S.C. §102(b) with regards to claims 1-5, 9, 11, 13, 15, and 16 for the reasons set forth above. Furthermore, a 35 U.S.C. § 103 rejection of these claims

would be inappropriate as well. Applicants' claimed invention is not an obvious extension of the use of Petrovich to meet Applicants' patentable limitations. See the below remarks with respect to the 35 U.S.C. § 103 rejection for even further details.

Further remarks with regard to the patentable distinctions of Applicants' claimed invention over Petrovich are provided below with respect to, for example, dependent claims 2, 3, 5, and 16.

For example:

With respect to claim 2, the Examiner states that Petrovich discloses that the means for inputting information can be a radio receiver (transceiver or radiophone), said radio receiver receives signals from a radio transmitter coupled to a merchant computer, whereby the merchant computer transmits product information in response to a signal by said purchasing aid logistics appliance for product information. Applicants respectfully point out that Petrovich discloses a radiophone for communication between the home cradle and home personal computer (col. 6, lines 5-24) and a transceiver for wireless communication with a wireless multi-access point 18 in the shopping establishment (col. 5, lines 9-14). Applicants further respectfully point out that the wireless communication is used for notifying the user when the user has deviated from a efficient path for finding goods, the list and location of which is pre-stored in portable terminal 40 (col. 10, lines 39-50). Nowhere does Petrovich disclose Applicants' claimed merchant computer's transmitting product information in response to a signal by the purchasing aid logistics appliance for product information.

With respect to claim 3, the Examiner states that Petrovich discloses that the means for inputting information is an internet port, said internet port is connectable to a personal computer (32) linked to a merchant web site (16), whereby the merchant web site downloads product information to said internet port in response to a signal by the personal computer for product

information. Applicants respectfully point out that Petrovich discloses a host computer 16 within the shopping establishment 14 that can be internet-accessible to the personal computer 32 at home 12 (col. 3 lines 64-67, col. 4 lines 1-5). Nowhere does Petrovich disclose Applicants' claimed merchant web site whereby the merchant web site downloads product information to said internet port in response to a signal by the personal computer for product information. A host computer at a shopping establishment is clearly different from a merchant's web site.

With respect to claim 5, the Examiner states that Petrovich discloses that the central processor compares said shopping list to said bar code signals to determine whether product is a new product to add to said shopping list or an existing product (col. 10, lines 1-18), whereby said central processor tracks the total cost of products scanned, the remaining products to be scanned, and the available funds remaining in the budget. Applicants respectfully point out that Petrovich discloses that a query can be made about the final price and order confirmation (col. 11, lines 19-21), but nowhere does Petrovich disclose that a central processor tracks the total cost of products scanned, the remaining products to be scanned, and the available funds remaining in the budget.

With respect to claim 16, the Examiner states that Petrovich discloses that the means for outputting controls signal strength to communicate with a merchant sales register to minimize the possibility of transmission interception (col. 4, lines 20-22). Applicants respectfully point out that Petrovich discloses a shopping establishment kiosk cradle with a portable terminal receiving station and interface that is associated with the portable terminal receiving station. The kiosk optical interface is located so as to communicate with a two-way data interface of the portable terminal when the portable terminal is placed in the receiving station. Applicants further respectfully point out that the two-way data interface is configured to read bar codes, and is configured for data exchange with the kiosk data interface (col. 4, lines 50-67). Nowhere does

Petrovich disclose controlling signal strength for any reason, including to minimize the possibility of transmission interception.

With regards to independent claim 18, the Examiner states that Petrovich discloses a method for using a purchasing aid logistics appliance (40) comprising:

- downloading product data from a web site or bar coded advertisement;
- creating a shopping list from said product data;
- transmitting said shopping list to a merchant computer upon entry into a merchant facility (24 linked to 16);
- receiving product data from said merchant computer upon entry into said merchant facility;
- scanning a product bar code when a product is removed from the shelf and placed in a shopping cart for purchase (col. 12, lines 35-36);
- creating a shopping cart file when said product is scanned; and
- transmitting said shopping cart file to said merchant computer to checkout.

However, the Examiner has not provided the Petrovich citations for many of the steps in Applicants' claim 18, for example:

- receiving the product data from the merchant computer upon entry into the merchant facility;
- creating a shopping cart file when a product is scanned; or
- transmitting the shopping cart file to the merchant computer to checkout.

Applicants have reviewed Petrovich and could not find expressed or inherent reference in Petrovich to the above mentioned recited steps of claim 18. Since it appears that Petrovich does not set forth each and every element of Applicants' claim 18, either expressly or inherently, Applicants' claim 18 is not anticipated by Petrovich and a rejection under 35 U.S.C. §102(b) is inappropriate. Therefore, Applicants respectfully request the withdrawal of the rejection under

35 U.S.C. §102(b) with regards to claim 18 for the reasons set forth above. Furthermore, a 35 U.S.C. § 103 rejection of these claims would be inappropriate as well. Applicants' claimed invention is not an obvious extension of the use of Petrovich to meet Applicants' patentable limitations.

With regards to independent claim 19, the Examiner states that Petrovich discloses a purchasing aid logistics appliance (40) comprising:

- means for creating a shopping list outside a merchant facility (32, 16);
- means for storing said shopping list and user personal information (16, 40);
- means for automatically uploading said shopping list to a merchant computer upon entry into said merchant facility (24);
- means for two-way data and voice communication (col. 12, lines 9-27) with said merchant computer;
- means for displaying said shopping list (72);
- means for optically inputting product information data (bar code reader);
- means for electronic payment (col. 5, lines 55-63); and
- means for calculating total price of items selected (checkout terminal 56).

Applicants respectfully disagree with the Examiner's rejection of claim 19. For example, Applicants respectfully assert that Petrovich does not have the "means for automatically uploading said shopping list to a merchant facility upon entry into the merchant facility." Petrovich requires the user to dock the purchasing aid logistics appliance (40) in a kiosk cradle 24 (col. 12, lines 28-30). The mere act of docking the purchasing aid logistics appliance (40) in a kiosk cradle (24) contradicts the act being "automatic". Even if the shopping list is automatically uploaded when the purchasing aid logistics appliance (40) is docked in the kiosk cradle (24), Petrovich requires an affirmative or non-automatic act by the user to dock the purchasing aid logistics appliance (40) to take full advantage of the electronic shopping system. Further,

Petrovich does not disclose that the shopping list is automatically uploaded when the purchasing aid logistics appliance (40) is docked in the kiosk cradle (24). Petrovich discloses that the appropriate shopping list in memory (46) is downloaded and stored in the database in host computer (16) (col. 12, lines 30-32). Applicants respectfully assert that Petrovich does not disclose whether the step of downloading the shopping list requires user intervention or is automatic when the purchasing aid logistics appliance (40) is docked in a kiosk cradle (24). Petrovich does not disclose or suggest that the step of uploading the shopping list to the merchant facility is automatic without user intervention, such as placing purchasing aid logistics appliance in a dock.

Applicants further respectfully disagree with the Examiner's rejection of claim 19 based upon, for example, the Examiner's assertion that Petrovich discloses "means for electronic payment." Petrovich discloses that a credit card or debit card information can be entered into the purchasing aid logistics appliance (40) or directly into host computer (16) (col. 5, lines 61-63). However, Petrovich lacks a means for electronic payment for purchases at the checkout terminal (56). Petrovich, on the other hand, and contrary to Applicants' claim 19, discloses that the user tenders payment at the check out terminal (col. 12, line 54). Petrovich does not disclose or suggest that the payment is tendered electronically by way of the purchasing aid logistics appliance (40). Petrovich may disclose that the shopping list can be up-loaded to check out terminal (56) and printed (col. 12, lines 55-56), but Petrovich does not teach or suggest that credit or debit card information could also be up-loaded to the check out terminal (56).

A further example of the patentability of Applicants' invention as set forth in claim 19 resides in Applicants' claimed element of "means for calculating total price of items selected." Nowhere does Petrovich disclose a purchasing aid logistics appliance means for calculating total price of items selected.

Since Petrovich does not set forth each and every element of Applicants' claim 19, either expressly or inherently, Applicants' claim 19, as well as amended claim 20 that depends therefrom and that further defines the invention, is not anticipated by Petrovich and a rejection under 35 U.S.C. §102(b) is inappropriate. Therefore, Applicants respectfully request the withdrawal of rejections under 35 U.S.C. §102(b) with regards to claim 19 for the reasons set forth above. Furthermore, a 35 U.S.C. § 103 rejection of these claims would be inappropriate as well. Applicants' claimed invention is not an obvious extension of the use of Petrovich to meet Applicants' patentable limitations. See the below remarks with respect to the 35 U.S.C. § 103 rejection for even further details.

On page 5, paragraphs 14-15 of the Office Action, claims 12 and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Petrovich. The Examiner states that Petrovich does not specifically disclose that credit and debit card information along with a personal identification number are the first signal sent to a merchant computer. The Examiner states that Official Notice is taken that credit and debit information may be first sent to a merchant computer, followed by a list of products that are to be charged to the credit or debit card, and that it would have been obvious to one having ordinary skill in the art at the time the invention was made to submit credit or debit card information before a product list.

However, Applicants respectfully point out that claims 12 and 14 depend from claim 11, which depends from claim 1. In order for a rejection under 35 U.S.C. §103 to be sustained, the Examiner must establish a prima facie case of obviousness. As pointed out in Section 2142 of the MPEP, one of the three criteria to establish a prima facie case of obviousness is that the prior art reference(s) must teach or suggest all the claim limitations. As discussed above by Applicants in the Remarks/Arguments of the 35 U.S.C §102(b) rejections, Petrovich does not anticipate all the claimed limitations of claim 1. Further, Petrovich does not suggest the claimed limitations of

claim 1 not anticipated by Petrovich. Therefore, Petrovich combined with the Official Notice is not sufficient to sustain a rejection under 35 U.S.C. §103 for claims 12 and 14.

Furthermore, Applicants respectfully rebut the Official Notice taken that credit and debit information may be first sent to a merchant computer, followed by a list of products that are to be charged to the credit or debit card, and that it would have been obvious to one having ordinary skill in the art at the time the invention was made to submit credit or debit card information before a product list. Applicants respectfully point out that, "[O]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961))." *MPEP*, 2144.03 A. Applicants herein respectfully traverse the Examiner's Official Notice.

Applicants respectfully point out that a first signal sent to a merchant computer may not necessarily include credit and debit card information along with a personal identification number. Applicants have established a protocol between the merchant facility and the purchasing aid logistics appliance that suits the needs of both. Applicants respectfully point out that protocol design choices are not generally obvious to one skilled in the art out of context of the complete system.

Therefore, Applicants respectfully request the withdrawal of rejections with regards to claims 12 and 14 under 35 U.S.C. §103(a) as being unpatentable over Petrovich for the above stated reasons.

On page 5, paragraphs 14-15 of the Office Action, claim 8 is rejected under 35 U.S.C. §103(a) as being unpatentable over Petrovich in view of Molbak et al., WIPO Patent Publication

No. WO 01/20526 (WO '526). The Examiner states Petrovich fails to disclose inputting information with a keypad. Further the Examiner states that it is well known in the art to use a keypad to enter information, as taught by WO '526. Still further, the Examiner states that keypads are commonly used to input information when bar code readers or magnetic card readers fail. Still further, the Examiner states that it would have been obvious to one having ordinary skill in the art at the time the invention was made to input information in Petrovich by used a keypad as shown by WO '526.

Applicants respectfully point out that claim 8 depends from claim 1. In order for a rejection under 35 U.S.C. §103 to be sustained, the Examiner must establish a *prima facie* case of obviousness. As pointed out in Section 2142 of the MPEP, one of the three criteria to establish a *prima facie* case of obviousness is that the prior art reference(s) must teach or suggest all the claim limitations. As discussed above by Applicants in the Remarks/Arguments of the 35 U.S.C §102(b) rejections, Petrovich does not anticipate all the claimed limitations of claim 1. Further, Petrovich does not suggest the claimed limitations of claim 1 not anticipated by Petrovich. Therefore, Petrovich combined with WO '526 is not sufficient to sustain a rejection under 35 U.S.C. §103 for claim 8.

A further example of the patentability of Applicants' invention as set forth in claim 8 resides in fact that WO '526 discloses the use of a *keyboard* (WO '526 Specification, page 6, line 17), but nowhere does WO '526 disclose or suggest a *keypad*. The conventional keyboard that WO '526 discloses is a typical QWERTY-style input mechanism, whereas the keypad of Applicants' claim 8 supports operations on information that is brought into the system of the present invention in its entirety through a high-density bar code reader (see Applicants' specification, paragraph 28). Further, WO'526 teaches away from the use of a keypad as used in Applicants' invention.

Therefore, Applicants respectfully request the withdrawal of the rejection with regards to claim 8 under 35 U.S.C. §103(a) as being unpatentable over Petrovich in view of Molbak et al., WIPO Patent Publication No. WO 01/20526 (WO '526) for the reasons stated above.

On pages 5-6, paragraphs 17-19 of the Office Action, claims 6, 7, 10, and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Petrovich in view of Ogasawara, United States Pat. No. 6,123,259 (Ogasawara). In paragraph 17, the Examiner states that Petrovich fails to disclose the central processor to include software to convert bar code signals into a web page to be displayed on the display or that the software includes HTML, JAVA and WAP decode tables. The Examiner states that Petrovich also fails to disclose a smart card reader and a smart card storing a user personal identification number.

In paragraph 18, the Examiner states that Ogasawara teaches a portable device with a processor that includes software to convert bar code signals to control the display (col. 5, lines 1-8), and that using the bar code signal to control display gives the user an updated display of transactions. The Examiner further states that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Petrovich as taught by Ogasawara such that the bar code signal control the display, so the user has a visual record of updated transactions. The Examiner still further states that Official Notice is taken that many displays are created using HTML, JAVA, or WAP code that has been decoded. The Examiner states that it is also well known to have a parser with a modifying table to construct frame software and a display browser. The Examiner states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement an HTML, JAVA, or WAP decoder to update and control the visual display.

In paragraph 19, the Examiner states that Ogasawara teaches a portable shopping device that interfaces with a smart card. The Examiner further states that the smart card contains pertinent user data, and that by using a smart card, the user data are secured and access to

personal information is limited. The Examiner states that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Petrovich as taught by Ogasawara in order to limit access to personal information.

However, Applicants respectfully point out that claim 1 is the base claim for claims 6, 7, 10, and 17. In order for a rejection under 35 U.S.C. §103 to be sustained, the Examiner must establish a prima facie case of obviousness. As pointed out in Section 2142 of the MPEP, one of the three criteria to establish a prima facie case of obviousness is that the prior art reference(s) must teach or suggest all the claim limitations. As discussed above by Applicants in the Remarks/Arguments of the 35 U.S.C §102(b) rejections, Petrovich does not anticipate all the claimed limitations of claim 1. Further, Petrovich does not suggest the claimed limitations of claim 1 not anticipated by Petrovich. Therefore, Petrovich combined with Ogasawara and the Official Notice is not sufficient to sustain a rejection under 35 U.S.C. §103 for claims 6, 7, 10, and 17.

A further example of the patentability of Applicants' claimed invention recited in claim 6 resides in fact that Applicants claim a central processor that includes executable software to convert bar code signals into a web page. Applicants respectfully point out that Ogasawara discloses a bar code scanner 15 that is coupled to a control unit 20 that controls the operation of the display 10 (col. 5, lines 1-8). Nowhere does Ogasawara disclose or suggest converting bar code signals into a web page.

Furthermore, Applicants respectfully rebut the Official Notice taken that many displays are created using HTML, JAVA, or WAP code that has been decoded, and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement an HTML, JAVA, or WAP decoder to update and control the visual display. Applicants respectfully point out that, "[O]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge

in the art are capable of instant and unquestionable demonstration as being well-known. Applicants herein respectfully traverse the Examiner's Official Notice. Even though a display might be created using HTML, JAVA, or WAP code that has been decoded, Applicants' novel use of translating bar code information to the commands that are required to display a web page is not obvious to one skilled in the art. Further, Applicants set forth in claim 7 converting a bar code that contains any of HTML, JAVA, or WAP code into a web page. Such flexibility is neither disclosed or suggested by Ogasawara, nor is it obvious to one skilled in the art.

In view of the absence from any cited patent of Applicants' claimed invention as set forth above, Applicants respectfully urge that Petrovich, WO '526, Ogasawara, and Office Notices, separately or in combination, are legally insufficient to render the presently claimed invention obvious under 35 U.S.C. § 103.

Claims 1-20 are believed to be in condition for allowance. All dependent claims are believed to depend upon allowable independent claims, and are therefore also in condition for allowance.


Enclosed herein is a petition for a one-month extension of time and the appropriate fee (\$110) for a large entity. No additional claims have been added beyond the claims originally paid for. The Commissioner for Patents is authorized to charge additional fees or credit overpayment to Deposit Account No. 03-2410, Order No. 12078-129.

The following information is presented in the event that a call may be deemed desirable by the Examiner: PETER J. BORGHETTI (617) 854-4000.

Respectfully submitted,
Joseph Claude Caci et al., Applicants

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By:



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